



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,638	03/14/2001	Mary Faris	G&C 129.35-US-01	5083

36327 7590 01/03/2006

AGENSYS C/O MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

EXAMINER

HARRIS, ALANA M

ART UNIT	PAPER NUMBER
----------	--------------

1643

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,638

Applicant(s)

FARIS ET AL.

Examiner

Alana M. Harris, Ph.D.

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 14 and 23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 14 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09/01/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 02, 2005 has been entered.

2. Claims 1, 14 and 23 are pending.

Claims 1, 14 and 23 are examined on the merits.

Maintained Grounds of Rejection

Claim Rejections - 35 USC § 102

3. The rejection of claims 1, 14 and 23 under 35 U.S.C. 102(e) as being anticipated by WO200270539 A2 (filed March 5, 2002/ IDS reference 2, April 15, 2001) is maintained.

Applicants assert that an electronic mail (email) message was discussed in a previous response filed May 9, 2005 and Applicants inadvertently omitted the said message from the filing, see Remarks submitted November 03, 2005. Applicants' submission of the email from Dr. Mitchell to his colleagues regarding sequences germane to the claimed invention allegedly support Applicants' claim that they were in

Art Unit: 1643

possession the claimed subject matter prior to the WO document and believe this showing is sufficient to demonstrate Applicants' conception and reduction to practice prior to the prior art. The Examiner has carefully reviewed the email, as well as all submissions by Applicants after final. These points of view and arguments have been carefully reviewed and considered, but found unpersuasive.

The Examiner has not found any record of Applicants noting in earlier responses that an email was presented as evidence in hopes of antedating the prior art reference of record. Notwithstanding, Applicants' email simply lists a nucleotide and amino acid sequence that purportedly is SEQ ID NO: 1 and SEQ ID NO: 2, respectively. There is no information regarding how many residues each sequence consists of and that the sequences listed in the email are the same as that claimed. Moreover, this submission is not presented with a declaration under 37 C.F.R. 1.131 attesting and swearing to the facts that this is not new matter or is the same as that claimed, nor have any of the inventors signed a declaration verifying the information presented in the email.

The evidence submitted continues to be insufficient to establish a conception of the invention prior to the effective date of the prior reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicants must provide a showing of facts to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior

Art Unit: 1643

to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the WO reference to either a constructive reduction to practice or an actual reduction to practice.

In the instant case Applicants have not provided sufficient evidence substantiating the assertion they were in possession of the claimed subject matter prior to the filing date of the WO document. Accordingly, the rejection is maintained for reasons cited above and of record in the Detailed Action mailed October 4, 2004. Applicants are requested to review MPEP 715 and the section therein.

Double Patenting

4. The provisional rejection of claims 1, 14 and 23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12-17, 19, 21, 26, 51 and 52 of copending Application No. 10/099,460 (filed March 13, 2002) is maintained.

5. Claims 1, 14 and 23 continue to be directed to an invention not patentably distinct from claims 1, 12-17, 19, 21, 26, 51 and 52 of commonly assigned co-pending

application 10/099,460 (filed March 13, 2002). Specifically, both sets of claims read on identical nucleotide sequences and the encoded polypeptide sequence.

6. As set forth in the Action mailed October 4, 2004, the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned 10/099,460 (filed March 13, 2002), discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alana M. Harris, Ph.D. whose telephone number is

Art Unit: 1643

(571)272-0831. The examiner works a flexible schedule, however she can normally be reached between the hours of 7:30 am to 6:30 pm with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry R. Helms can be reached on (571) 272-0832. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALANA M. HARRIS, PH.D.

PRIMARY EXAMINER



Alana M. Harris, Ph.D.

27 December 2005